IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE APPLICATION OF	:	Jason Sulak et al.
FOR	:	ON-LINE SYSTEM FOR CREATING A PRINTABLE PRODUCT
SERIAL NO.	:	09/629,370
FILED	:	July 31, 2000
EXAMINER	:	Namitha Pillai
ART UNIT	:	2173
ATTORNEY DOCKET NO.	:	109769.0020

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BRIEF OF APPELLANT UNDER 37 C.F.R. § 1.192

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is Appellant's brief, filed in triplicate, to the Board of Patent Appeals and Interferences in support of the patentability of the claims in the above-identified application. This appeal stems from the final Office action mailed July 9, 2003, finally rejecting claims 1-26 of the subject application. A Notice of Appeal from the final rejection was deposited with the United States Postal Service as First Class mail on November 10, 2003, and received by the Patent Office on November 12, 2003. Please charge the $330.00 fee for filing an appeal brief, and any other fees resulting from this communication, to Account No. 50-0959, referencing our Docket No. 109769.0020.

I. REAL PARTY IN INTEREST

The subject application was filed on August 20, 2002, naming Jason Sulak, Andrew Cohen, and Bruce Petro (hereinafter collectively referred to as "appellants") as the inventors. Appellants' right, title and interest was subsequently assigned to American Greetings Corporation by virtue of three Instruments of Assignment executed on March 2, 2001, March 2, 2001, and February 6, 2001, respectively. The assignment of the appellants' interest was recorded on June 1, 2001 at Reel 011857, Frame 0506.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences related to this application known to appellants, appellants' legal representative, or appellants' assignee.

III. STATUS OF CLAIMS

The application was originally filed with twenty one (21) claims. In response to an initial Office action, appellants amended claims 1, 10, 13 and 14; cancelled claims 6 and 7; and added new claims 22-26. Claim 8 was amended merely to correct the dependency of that claim in response to a final Office action, however, a subsequently issued Advisory Action provided no indication as to whether the amendment to claim 8 was entered for purposes of this appeal. None of the claims have been identified by the Examiner as being directed toward allowable subject matter.

In sum, the status of the claims in the subject application is as follows:

Claims 10-12 stand rejected under 35 U.S.C. §102(e);

Claims 1-5, 14-19 and 22-25 stand rejected under 35 U.S.C. §103(a);

Claims 13 and 26 are rejected under 35 U.S.C. §103(a);

Claims 8-9 and 20-21 stand rejected under 35 U.S.C. §103(a); and

Claims 6 and 7 have been cancelled.

A complete listing of the claims in the present application, as they stand at the time of this appeal, are presented in the attached appendix.

IV. STATUS OF AMENDMENTS

As mentioned above, an amendment to claim 8 was filed in response to the final rejection of the claims in the subject application. This amendment merely changed the dependency of claim 8 from claim 7, which was cancelled, to claim 1. Appellants remarks in this brief are based on the claims as listed in the attached appendix, including the amendment to claim 8.

V. SUMMARY OF THE INVENTION

The present invention is directed toward a system for creating and printing social expression products by a user at his or her home computer over the Internet. The system utilizes a plug-in program that is executed in the web browser application the user uses to access the Internet. The program is downloaded from a web server which stores the plug-in program, said web server also being used to store a multitude of files, each representing a printable social expression product (e.g. a greeting card), and each consisting of one or more design elements ranging from graphics to regular text and attributes of those elements such as position or color.

The user accesses the Internet using the web browser from a client computer and enters a web server address that corresponds to a request for the file of a specific printable product. Upon download of the file of a specific printable card, the client's web browser either detects the presence of the plug-in or determines if installation of the plug-in is required. The plug-in is then installed, if necessary. When the download option is selected, the plug-in program residing on the user's computer detects and opens the file or files containing data defining the selected card. Importantly, the plug-in program enables the user to modify, edit and add the design elements using the existing web browser. The plug-in then assembles the modified design elements into the card. The plug-in then processes the card to enable printing of the card on a local printer. Thus, the user is able to print, for example, a greeting card at his or her home, without having to

download a large database of images or existing cards, and to modify the card without having to download or install a separate application, and print the greeting card at home.

VI. ISSUES

1. Whether customization of a web page being displayed by a web-browser program utilized by a computer for displaying such web pages is a modification to the web-browser program itself, or, merely a modification of what is to be retrieved and displayed by the web-browser program.

2. Whether an executable program, referred to as an applet, that provides enhanced functionality to a displayed web page is a program, referred to as a plug-in, to be installed to alter, enhance, or extend the operation of a web-browser program.

3. Whether the references combined to reject the claims of the subject application under 35 U.S.C. §103(a) possess the required motivation to justify their combination.

VII. GROUPING OF CLAIMS

Appellants concede, for purposes of this appeal, that the claims stand or fall together as grouped.

VIII. ARGUMENTS

A.   The Rejections Under 35 U.S.C. §102(e)

The rejection of claims 10-12 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,311,214 to Rhoads is improper because Rhoads does not disclose each and every element of the invention as claimed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

As an initial matter, applicants note a distinction made in the present application between a web page and a web browser. The Office action states that "Roads discloses using modifying a browser program, *represented as the website*, wherein the client computer uses this

website/browser to edit the defining data for the printable product." (See Office action, page 2, 2nd sentence of the detailed rejection of claim 10) (emphasis added). According to the present application, each page of information, commonly referred to as a web page or web site, is identified by a Universal Resource Locator ("URL") which identifies the server on which the web site is stored and the location of that particular web site on the server. (See page 6, lines 1-5). A web browser program, on the other hand, is a piece of software used by a computer to communicate with networks of servers to retrieve and display web pages identified by a particular URL. (See page 6, lines 11-26). The Office action appears to equate modifying a web site to modifying a browser program when, in fact, these are two distinct operations.

For instance, a passage of Rhoads cited in the Office action teaches that a purchaser of a card including identifying data can link the identifying data to a customizable web site. Once customized, the web site displays a personalized greeting to the intended recipient of the card when the recipient enters the identifying data from the card into a personal computer networked to the Internet. Rhoads goes on to teach that to customize the web site, the purchaser of the card is provided with simple editing tools to personalize the *web greeting*. (See Col. 10, lines 24-26) (emphasis added). This customization of the web site, however, is not the equivalent of the modification of the browser according to the present application, as expressing defined by the pending claims. Instead, customization of the web site is merely a modification of what is to be retrieved and displayed by the web browser.

In light of the above distinction, the present application teaches a program enabling a user to create and print a social expression product (greeting card) at his or her home computer. Claim 10 was previously amended to recite the limitation of means for modifying a browser program on a personal computer of a user to allow the user to edit the defining data within the browser program. As taught in the present application, the means for modifying the browser program is a plug-in which extends the capabilities of the browser to allow the user to download and edit data defining a social expression product (greeting card) within the browser program. The plug-in is a small piece of software loaded into memory by a larger program, i.e., the web browser, that adds a new feature to the browser. (See page 7, lines 9-15). One function of the engine component of the plug-in is to make selected assets, such as design elements defined by the defining data, for a printed product available in the browser such that they can be edited by the user. (See page 9,

lines 23-25). Thus, the desired assets are selected by the user from assets stored on the server and downloaded to the user's computer to be customized by the user. Modifying the assets downloaded to the user's computer does not modify the assets selected from the server. <u>The assets that were downloaded and modified by the user remain in their original form on the server for others to download and modify to fit their needs</u>.

Applicants respectfully traverse the Examiner's rejection of claim 10 as anticipated by Rhoads. The Rhoads patent discloses a system for creating a personalized greeting on a web site and linking that web site with a greeting or other type card via a personal computer terminal having a web browser at a user's home. According to Rhoads, the user selects and optionally customizes the appearance of the card by visiting a web site specializing in greeting cards. The web site and the information pertaining to the card are retrieved from a server. No further details are provided in Rhoads about the customization of the card and whether the customization is performed by a plug-in within the browser program or if the customization is merely the selection of desired decorative designs from the server. Rhoads is also <u>completely silent</u> about modifying the browser program to perform such modification within the browser program, and about modifying the downloaded data defining said decorative designs to appear on the printable product.

In contrast, the present application teaches and claims that the program code includes <u>means for modifying a browser program</u> to allow the user to edit the data defining the printable product within the <u>browser program</u>. From the present application, it is clear that the first program, i.e., the plug-in, is to be downloaded and installed on the user's computer. (See page 8, lines 16-18). Data defining the selections made by the user over the Internet regarding the decorative designs that are to be assembled on the card are downloaded to the user's computer as an appropriately formatted file, such as a CPT file, for example. (See page 12, lines 1-7). The display, *editing* and assembly of the printable product defined by the downloaded file is to be performed by the plug-in, which is installed on the user's computer. (See page 12, lines 7-8). Rhoads makes no mention of modifying the browser program on the user's computer or editing the defining data within the browser program once the defining data is downloaded to the user's computer as claimed in claim 10.

Reversal of the final rejection of claims 10-12 under 35 U.S.C. §102(e) for failure of the Rhoads reference to disclose each and every element of the claims is respectfully requested.

B. The Rejections Under 35 U.S.C. §103(a)

(1) The Combination of References Fails to Disclose Every Claim Limitation

The rejection of claims 1, 14, 22 and 23 under 35 U.S.C. §103(a) as being unpatentable over the combined teachings of Rhoads and U.S. Patent No. 5,742,768 to Gennaro et al. is improper because the combination fails to teach every limitation recited in those claims. Rhoads is relied upon in the final Office action as disclosing every claim limitation except for downloading a first program (i.e., the plug-in) that provides modification functions for modifying defining data and assembly functions for assembling a printable product. Although Gennaro et al. discloses the provision of an applet to enhance the functionality of a web page, the first program to be downloaded in the above claims is patentably distinct from the applet.

It is well settled that the burden is on the Examiner to establish a prima facie case of obviousness. M.P.E.P. §2142 (8th Ed.). The first prong of the Examiner's prima facie case of obviousness is that the combination of references must teach or suggest all the claim limitations, and provide a reasonable expectation of success. M.P.E.P. §2143.03; *See also In re Dance*, 160 F.3d 1339 (Fed. Cir. 1998); *In re Royka*, 490 F.2d 981 (CCPA 1974). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

As discussed above regarding the rejection of claims 10-12, Rhoads does not teach downloading a program to the user's computer for modifying data defining designs (such as greeting cards), as defined by claims 1, 14, 22 and 23. The selection and optional customization of a card at the web site of a vendor that specializes in greeting cards disclosed by Rhoads is patentably distinct from the customization of the card with a downloaded program on the computer of the user. Rhoads teaches that the customization of the card is performed by

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personally selecting a card from available designs offered on the vendor's server over the Internet. In contrast, the present application specifies that the <u>first program</u>, i.e., the plug-in, is <u>downloaded and installed on the user's computer</u>. (See page 8, lines 16-18). Data defining the selections made by the user over the Internet regarding the decorative designs that are to be assembled on the card are downloaded to the user's computer as an appropriately formatted file, such as a CPT file, for example. (See page 12, lines 1-7). The display, *editing* and assembly of the printable product defined by the downloaded file is performed by the plug-in, which is installed on the user's computer. (See page 12, lines 7-8). Thus, if the design assets offered on the vendor's web site do not satisfy the user, the user can download design assets to the user's computer and modify those downloaded assets with the plug-in according to the user's own preferences. Rhoads makes no disclosure or suggestion at all of such features, which are expressly defined by the claims.

This omission in the teachings of Rhoads is not remedied by the teachings of Gennaro et al. Although Gennaro et al. discloses the use of an executable program attached to a web site to enhance the functionality of the displayed web site, this is not comparable to the downloading and installation of a "first program" as claimed in the present application. As noted above, the first program is clearly defined as a plug-in that is installed to alter, enhance, or extend the operation of a parent application program, which, in the present application, is the web browser program. (See page 7, lines 11-19). Plug-ins of the type described in the present application are pieces of software that are installed on the user's computer. (See page 8, lines 16-18). They typically can be opened directly from the operating system of the computer on which they are installed. Further, once a plug-in is installed, it can serve to enhance the operation of the parent application, i.e., the web browser, in displaying or using other web sites.

Unlike the plug-in of the present application, the executable program downloaded in Gennaro et al. is explicitly defined as an applet. (See Col. 2, lines 7-11; Col. 3, lines 38-42). Gennaro et al. explains that the applet provides enhanced functionality *to the displayed web page*. (See Col. 3, lines 58-64) (emphasis added). Applets are programs that cannot be executed directly from the operating system. Rather, they are designed to be executed from within another application, which is the web browser in Gennaro et al., and only serve to enhance the functionality of the web browser in displaying the particular web site in which the applet is

embedded. And even assuming that the applet of Gennaro et al. is comparable to the first program claimed in the present application (a comparison with which Applicant disagrees), the applet of Gennaro et al. fails to provide the user with the ability to modify data defining decorative designs, as expressly claimed by this application. The applet merely provides the user with pull-down menus to permit the user to make desired selections, which is not the same function as modifying the selected defining data. Thus, Gennaro et al. also fails to teach downloading a program to the user's computer for modifying data defining decorative designs, as claimed in claims 1, 14, 22 and 23.

(2) The References Lack Motivation to Combine

The rejections of claims 1, 14, 22 and 23 under 35 U.S.C. §103(a) as being unpatentable over Rhoads and Gennaro et al. are also improper because the motivation required to justify their combination is missing. And even if these teachings were combined, the alternate method of providing information to a remote user of a network via an applet as taught by Rhoads and Gennaro et al. would lead one of ordinary skill in the art away from downloading a plug-in to the remote user's computer.

The second prong of the Examiner's prima facie obviousness case is that the Examiner must establish some suggestion or motivation to combine reference teachings. M.P.E.P. §2143.01. "There are three possible sources for a motivation to combine the references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-1458 (Fed. Cir. 1998). A prima facie case of obviousness can be rebutted, however, by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 U.S.P.Q.2d 1362, 1366 (Fed. Cir. 1997).

There would be no motivation for one of ordinary skill in the art to download a program to the user's computer to perform the modification of the defining data when apprised of the teachings of Rhoads and Gennaro et al., alone or in combination. Both references teach away from the present invention by providing alternate methods of allowing the user to select desirable content from a web site other than by downloading a plug-in to the user's computer.

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Reversal of the final rejection of claims 1, 14, 22 and 23 under 35 U.S.C. §103(a) for failure of the Rhoads and Gennaro et al. references to disclose each and every element of the claims, and for a lack of motivation to justify their combination is respectfully requested.

IX. CONCLUSION

The appellants have established that the Examiner's rejections of claims 10-12 as being anticipated by Rhoads, and claims 1, 14, 22 and 23 as being unpatentable over the combination of Rhoads in view of Gennaro et al. are unsupported factually by the references. The references not only fail to teach each and every limitation of the claims in the subject application, they also teach away from the claimed invention and thereby preclude a finding of motivation to justify their combination.

In view of the foregoing, an order directing withdrawal of all of the standing rejections and issuance of a notice of allowability is respectfully requested.

Respectfully submitted,

ROETZEL & ANDRESS

JAN. 12, 2004
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Jennifer C. Safranek

Date: 1.12.04

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APPENDIX OF CLAIMS

1.   A system for on-line creation of a printable product, the system comprising:

at least one server accessible via a computer network, said at least one server storing defining data defining a plurality of printable products including one or more design elements, and a first program providing a user with modification functions for modifying the defining data, and assembly functions for assembling a printable product suitable for printing;

a client computer for accessing said server, wherein said at least one server downloads said first program and said defining data to said client computers; and

a printer operatively coupled with said client computer, wherein said first program assembles printing data for printing the printable product on the printer.

2.   A system according to claim 1, wherein said plurality of printable products includes at least one of: announcements, banners, business cards, calendars, greeting cards, certificates, craft cards, envelopes, gift tags, invitations, labels, message cards, origami, postcards, posters, stationary, and stickers.

3.   A system according to claim 1, wherein said client computer includes a browser program for accessing said web server, wherein said first program enhances the functionality of said browser program.

4.   A system according to claim 3, wherein said first program controls the downloading to the client computer of the defining data that defines a selected printable product.

5.   A system according to claim 1, wherein said defining data defines
at least one of: graphical elements, text elements, and formatting data associated with the graphical and text elements.

6-7 (Canceled)

8.   A system according to claim 1, wherein said assembly of printing data includes at least one of: resizing, scaling, division into panels that anticipate printing in a desired printing format.

9.   A system according to claim 1, wherein said modification function of said first program includes modification to at least one of : font, color, alignment, position within a panel, adding a design element, and deleting a design element.

10.   A computer usable medium having computer readable program code means embodied therein for creating, modifying and printing of a printable product, the computer readable program code means comprising:

means for modifying a browser program on a personal computer of a user to allow the user to edit the defining data within the browser program:

means for downloading data defining a printable product;

modification means for modifying the defining data; and

print formatting means for formatting the defining data for printing.

11.   A computer readable program code means according to claim 10, wherein said modification means includes means for manipulating one or more design elements.

12.   A computer readable program code means according to claim 11, wherein said design elements includes at least one of: text, graphics, audio and video.

13.   A computer readable program code means according to claim 10, wherein said print formatting means performs at least one of the following functions:
resizing, scaling, and division into panels associated with a fold format.

14.   A method for generating a printable product using an online system accessible via a computer network, the method comprising:

storing on a server accessible via the computer network, data defining a plurality

of printable products including one or more design elements;

storing on the server a first program to enhance the functionality of a web browser program by providing a user with modification functions for modifying the defining data, and assembly functions for assembling a printable product suitable for printing, wherein the assembly and modification functions occur within the web browser program on a client computer;

downloading the first program to the client computer accessing the server through the web browser program, to provide for the user modification and printing of a printable product at the client computer; and

printing the printable product on a printer operatively coupled to the client computer.

15. A method according to claim 14, wherein said plurality of printable products includes at least one of: announcements, banners, business cards, calendars, greeting cards, certificates, craft cards, envelopes, gift tags, invitations, labels, message cards, origami, postcards, posters, stationary, and stickers.

16. A method according to claim 14, wherein said client computer includes a browser program for accessing said web server, wherein said first program enhances the functionality of said browser program.

17. A method according to claim 16, wherein said first program controls the downloading to the client computer of the defining data that defines a selected printable product.

18. A method according to claim 14, wherein said defining data defines at least one of: graphical elements, text elements, and formatting data associated with the graphical and text elements.

19. A method according to claim 14, wherein said method further comprises using the first program to assemble printing data for printing the printable product on the printer.

20.   A method according to claim 19, wherein said step of assembling printing data includes at least one of: resizing, scaling, division into panels that anticipate printing in a desired printing format.

21.   A method according to claim 14, where said modification function of said first program includes modification to at least one of: font, color, alignment, position within a panel, adding a design element, and deleting a design element.

22.   A system for enabling a user to create and print a social expression product over a computer network, comprising:

a web server;

a personal computer of the user having means for communicating with the web server over the computer network;

a web browser located on the personal computer of the user;

a database storing defining data defining a plurality of printable products including one or more design elements, said database communicatively coupled to the web server;

a plug-in program stored on the web server and downloaded to the web browser loaded on the personal computer of the user, the plug-in program providing the user with means for retrieving defining data from the database, means for modifying the retrieved defining data and means for assembling a social expression product on the personal computer of the user; and

a printer operatively coupled to the personal computer of the user, wherein the user is able to print a social expression product at the personal computer of the user.

23.   A system for enabling a user to create and print a social expression product over a computer network, comprising:

a web server;

a personal computer of the user having means for communicating with the web server over the computer network;

a web browser located on the personal computer of the user;

a storage device containing defining data defining a plurality of printable products including one or more design elements;

a plug-in program stored on the web server and downloaded to the web browser loaded on the personal computer of the user, the plug-in program providing the user with means for retrieving defining data, means for modifying the retrieved defining data and means for assembling a social expression product on the personal computer of the user; and

a printer operatively coupled to the personal computer of the user, wherein the user is able to print a social expression product at the personal computer of the user.

24.   A system according to claim 23 wherein said storage devices is one of a group consisting of a remote storage device, a web server, a personal computer, and a storage medium.

25.   A system according to claim 23, wherein said plug-in program further provides the user with means for adding design elements from an external source, said added design elements created by the user.

26.   A computer readable program code means according to claim 10, wherein said data defining a printable product is stored on one of a group consisting of a remote storage device, a personal computer, and a portable storage medium.

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First Named Inventor	Jason Sulak, et al.
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